

**REMARKS**

**A. Status of the Claims**

In the last Office Action, dated March 8, 2002, the Examiner rejected claims 33 and 34 under 35 U.S.C. § 112, second paragraph, and claims 32-64, 67, and 69-76 under 35 U.S.C. § 103(a).

By this amendment, Applicants cancel claims 32-64, 67, and 69-74 and add new claims 77-97. Support for Claims 77-97 can be found in Applicants' original, as-filed specification, at least at page 4, lines 4-18, and page 9, line 4-page 13, line 27. Further, new claims 78-97 correspond to original claims 35-42, 45-50, and 60-65, respectively. No new matter has been added by the addition of these claims. Therefore, after this amendment is entered, claims 75-97 are presently pending.

**B. Rejection Under 35 U.S.C. § 112, second paragraph**

The Examiner rejected claims 33 and 34 under 35 U.S.C. § 112, second paragraph, as indefinite. Although Applicants disagree with this rejection, they have cancelled claims 33 and 34, without prejudice, in the present Amendment. Accordingly, this rejection has been rendered moot and should be withdrawn.

**C. Rejections under 35 U.S.C. § 103(a)**

**1. Claims 32-64, 67, and 69-74 over Cotteret in view of Tsujino**

The Examiner rejected Claims 32-64, 67, and 69-74 over Cotteret (U.S. Pat. No. 5,514,188) in view of Tsujino (U.S. Pat. No. 4,961,925). Although Applicants disagree with this rejection, they have cancelled claims 32-64, 67, and 69-74, without prejudice, in the present Amendment. Accordingly, the rejection has been rendered moot and should be withdrawn.

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**2. Claims 75 and 76 over Yamahatsu**

Claims 75 and 76 stand rejected under 35 U.S.C. § 103(a) over Yamahatsu (EP 716,846), for reasons of record and additional reasons set forth on pp. 3-6 of the Final Office Action, mailed March 8, 2002.

Yamahatsu is drawn to oxidation dye compositions comprising oxidation dyes, uricase and uric acid. According to the Examiner, Yamahatsu, in his examples, "frequently uses a mixture of p-phenylenediamine, p-aminophenol and meta-aminophenol." Final Office Action, p. 3, lines 16-18. Yamahatsu does not teach or suggest any of the specific, substituted first oxidation bases presently claimed. Nevertheless, the Examiner contends that a "hair color chemist would know that Yamahatsu would substitute a primary intermediate for p-phenylenediamine . . . ." Final Office Action at p. 6, lines 13-14.

Applicants respectfully traverse this rejection with respect to all claims for reasons of record and because, as discussed below, the Examiner fails to establish a *prima facie* case of obviousness, fails to consider the invention as a whole, uses an incorrect standard for obviousness under 35 U.S.C. § 103(a), and uses impermissible hindsight.

**a. Fails to Establish a Proper *Prima Facie* Case**

In order to create a *prima facie* case of obviousness, the Examiner is required, among other things, to point to specific teachings or suggestions in the cited reference that would have motivated one skilled in the art to modify it in order to arrive at the claimed invention. M.P.E.P. § 2143. Here, the Examiner alleges that one skilled in the art would have arrived at the instantly claimed compositions in view of those disclosed

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in Yamahatsu by simply choosing and substituting a compound that is "equivalent" to para-phenylenediamine, as generally disclosed in Yamahatsu, from the list of compounds presently claimed. See, e.g., Final Office Action, p. 6, lines 11-16. Such an analysis is factually inaccurate and legally insufficient.

Specifically, Yamahatsu discloses many compositions, some of which indeed comprise para-phenylenediamine, para-aminophenol, and meta-aminophenol. Furthermore, Yamahatsu discloses a laundry list of 38 different dyes on page 3, lines 3-15, all of which are referred to generally as "oxidation dyes." Among these 38 compounds are certain derivatives of para-phenylenediamine, such as N-phenyl-para-phenylenediamine and N-phenyl-para-phenylenediamine acetate. *However, nowhere does Yamahatsu disclose any of the para-phenylenediamine derivatives found in Claims 75 and 76.* Nor does Yamahatsu disclose any of the specific double bases, ortho-aminophenols, pyridine derivatives, pyrimidine derivatives, pyrazole derivatives, or pyrazolopyrimidine derivatives contained in claims 75 and 76. Therefore, Yamahatsu is completely deficient in terms of teaching that the compounds claimed as the first oxidation base in the present compositions are "equivalent" to para-phenylenediamine. Absent such a teaching or motivation in the reference, a rejection of claims 75 and 76 under 35 U.S.C. § 103(a) is improper. Accordingly, Applicants respectfully request that such rejection be withdrawn for this reason alone.

**b. Fails to Consider the Invention as a Whole**

Throughout prosecution, the Examiner has repeatedly characterized the presently claimed compositions as differing from the compositions disclosed in Yamahatsu only by the "replacement" of one component with another that is

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"equivalent." Final Office Action, pg. 4, lines 10-12. In particular, the Examiner compares the claimed compositions with those disclosed in Yamahatsu and comes to the conclusion that Applicants are simply "substituting" a para-phenylenediamine derivative for para-phenylenediamine itself. Such an analysis is improper as it considers the claimed invention in a piecemeal manner rather than as a whole.

Indeed, when evaluating the scope of a claim, "every limitation in the claim must be considered" and "the claimed invention may not be dissected into discrete elements to be analyzed in isolation, but must be considered as a whole." M.P.E.P. § 2144.08(I). See also, M.P.E.P. § 2141.02. See also, M.P.E.P. § 2141.02 (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) ("In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.")(emphasis in original).

For example, the present invention is drawn not only to compositions wherein the first oxidation base is always a para-phenylenediamine. Instead, the first oxidation base can be chosen from specific double bases, o-aminophenols, pyridines, pyrimidines, pyrazoles, and pyrazolopyrimidines. The Federal Circuit has repeatedly emphasized that a proper analysis under 35 U.S.C. § 103(a) inquires as to whether the invention as a whole would have been obvious, not whether the *differences* between the claimed invention and a reference are obvious. For example, in *Thomas & Betts Corp. v. Litton Systems, Inc.*, the Court wrote:

An error into which T&B has fallen is its assumption that, in an inquiry under 35 U.S.C. § 103, one looks for the differences between the claimed invention and the prior art in the prior art. This is not the statutory standard. Rather,

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the statute directs a determination of whether the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious to a person having ordinary skill in the art.

*Thomas & Betts Corp. v. Litton Systems, Inc.*, 220 USPQ 1, 7 (Fed. Cir. 1983)(emphasis in original).

Therefore, the proper question under 35 U.S.C. § 103(a) is *not* whether the "substitution" of a para-phenylenediamine *derivative* in the claimed compositions for para-phenylenediamine in the compositions of Yamahatsu would have been obvious. Rather, the proper question is whether the combination of: 1) at least one first oxidation base chosen from the *particular species* claimed, 2) at least one second oxidation base as claimed, 3) at least one meta-aminophenol as claimed, 4) at least one 2-electron oxidoreductase, and 5) at least one donor for such enzyme would have been obvious over the teachings of Yamahatsu. A thorough analysis clearly shows that Yamahatsu does not contain a teaching or suggestion that would have motivated one skilled in the art to modify the disclosed compositions in order to arrive at those presently claimed. Such teachings or suggestions are simply absent. Accordingly, the claimed compositions would not have been obvious and Applicants respectfully request the rejection be withdrawn for this additional reason.

**c. Uses an Improper Standard for Obviousness**

As discussed above, the Examiner asserts that the instantly claimed compositions would have been obvious to one skilled in the art because all that is required to obtain the present invention is the "substitution" of para-phenylenediamine in

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the compositions of Yamahatsu with one of the specific oxidation bases contained in Claims 75 and 76. Applicants disagree.

Whether two components are "equivalent" is not the proper legal test for obviousness under 35 U.S.C. § 103(a). The predecessor to the Court of Appeals for the Federal Circuit held as much in *In re Scott*. In that case the CCPA stated, "The examiner and the board appear to hold that the mere existence of functional and mechanical equivalence establishes obviousness. We think this involves a non-sequitur. Expedients which are functionally equivalent to each other are not necessarily obvious *in view of* one another." *In re Scott*, 139 USPQ 297, 299 (CCPA 1963).

Therefore, the assertion that the claimed compositions are obvious under 35 U.S.C. § 103(a) because one skilled in the art could substitute one of the claimed compounds for the "equivalent" para-phenylenediamine found in the compositions of Yamahatsu is based on a legally inaccurate application of 35 U.S.C. § 103(a). Instead, a legally accurate application of the proper standard under 35 U.S.C. § 103(a) clearly demonstrates that Yamahatsu would not have taught or motivated one skilled in the art to modify the disclosed compositions to arrive at those that are presently claimed. Accordingly, Applicants respectfully request that the rejection be withdrawn.

**d. Use of Impermissible Hindsight**

The Examiner states that the claimed compositions would have been obvious to one skilled in the art because the working examples of Yamahatsu "nearly all," "frequently use," "nearly always," or "most frequently use" a combination of para-phenylenediamine, a para-aminophenol and meta-aminophenol. (Office Action, pg. 3, line 7; pg. 3, line 17; pg. 3, line 21; and page 4, lines 9). From these teachings, the

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Examiner asserts that it would have been obvious to one skilled in the art to arrive at the claimed compositions by replacing Yamahatsu's para-phenylenediamine with one of the "equivalent" compounds contained in the instant claims. Such an element-by-element analysis is improper and is symptomatic of what the Federal Circuit has called impermissible hindsight.

By comparing the claimed compositions to those disclosed in Yamahatsu on an element-by-element basis, it is clear that the Examiner is attempting to fit Yamahatsu's examples into the "mold" created by the claimed compositions. In other words, the Examiner is performing the obviousness analysis in a backwards manner. Rather than considering the reference itself and arriving at a conclusion that it suggests or teaches the claimed invention, the Examiner has first considered the claimed invention and then attempted to stitch it together from the alleged teachings of the reference.

Specifically, rather than reading the reference and pointing to a specific teaching or suggestion contained therein to motivate one of ordinary skill in the art to arrive at the claimed compositions, the Examiner compares components of the claimed compositions to those in Yamahatsu in a "checklist" manner and arrives at the conclusion that they would have been obvious to one skilled in the art. That this type of analysis is being used is clear from the way in which the Office Action is written. For example, when the Examiner states that Yamahatsu "nearly always uses" particular compounds, it is clear the reference as a whole is not being considered. Rather, only certain teachings are being considered and then only in light of Applicants' particular claimed compositions. What do the other examples in Yamahatsu that do not use such compounds suggest to one skilled in the art? Why would one skilled in the art choose

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to focus on those examples that "nearly always" use the particular compounds? Why would one skilled in the art choose the particular first oxidation bases, none of which are taught, at least one second oxidation base, at least one meta-aminophenol, at least one 2-electron oxidoreductase, and at least one donor for such enzyme in light of the laundry list in Yamahatsu containing at least 38 different chemical compounds? Why would one skilled in the art choose the very specific para-phenylenediamine derivatives contained in the instant claims if absolutely none of them are taught in the reference? The answers to such questions are critical to a proper analysis under 35 U.S.C. § 103(a). The Examiner has failed to ask or answer them. As such, the Applicants respectfully request that the rejection with respect to claims 75 and 76 be withdrawn.

### **3. Claim 77**

Applicants wish to point out that new Claim 77 recites, among other things, the same species of para-phenylenediamines, double bases, and ortho-aminophenols that are recited in Claim 75, none of which are taught in any of the cited references. Therefore, independent Claim 77 is patentable over the art of record for the same reasons as set forth above for Claims 75 and 76. Applicants respectfully request that the Examiner immediately allow Claims 75, 76, and 77-97.

### **CONCLUSION**

In view of the foregoing remarks, Applicants submit that the present claims, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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The Office is invited to contact Thalia V. Warnement at (202) 408-4454 if any matters may be resolved by a telephonic conference.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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